

REMARKS

At the time the Notice of Final Office Action was issued and mailed on December 28, 2007, Claims 1-21 were pending.

Claims 1-11 and 13-20 are currently amended.

No claims are canceled or added in this document.

Thus, claims 1-20 remain pending.

Applicants appreciate the Examiner's acceptance of the previously filed replacement drawings and the withdrawal of the objections to the drawings.

Applicants also appreciate the Examiner's acceptance of applicants' previous response and the resulting withdrawal of the rejection of Claims 1-3, 5-10, 14, and 20 based on 35 U.S.C. § 101.

Summary of Interview

The Examiner was kind enough to schedule a telephonic interview with applicants' representative on May 29, 2007. Prior to the scheduled interview, applicants' representative sent to the Examiner a proposed amendment and response to be filed in the case.

The Examiner agreed that the amendments to the claims would call for a further search and/or a further review of the cited art.

Applicants and their representative thank the Examiner for his time and consideration.

Claim Rejections under 35 U.S.C. § 102

Claims 1-4, 10, 11, 13-15, and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0019853 of Takizawa et al. (Takizawa). Applicants have amended Claims 1-4, 10, 11, 13-15, and 20 to further clarify the distinctions between the claims and the cited reference. Applicants traverse the rejection.

Applicants also have amended the claims to more clearly recite limitations in a manner which is consistent with the specification. To provide one example, in the specification, an example of an implementation of the invention describes taking a selection of text from a second document and inserting the selection in a first document. *See, for example*, Figures 4 and 5 and the associated description of those figures on pages 13-26 of the specification. By contrast, the originally filed claims described taking a selection of text from a first document and inserting the selection of text in the second document. The claims as amended do not recite the “first document” and “second document” nomenclature to avoid any potential confusion in the interpretation of the claims.

In the interest of reducing the number of issues for the Examiner to consider in this response, the following discussion focuses on independent Claims 1, 11, and 14, each of which is amended in this response. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants’ decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner’s conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants’ decision not to

discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. Moreover, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

Claim 1 is not anticipated by Takizawa because Takizawa fails to teach or suggest each and every element recited by Claim 1. Accordingly, the rejection under 35 U.S.C. § 102(e) must be withdrawn. Claim 1 as amended is reproduced below for the convenience of the Examiner:

1. (Currently Amended) A method of formatting representing a selection of text from a first document as an Extensible Markup Language (XML) formatted selection such that the selection of text carries formatting properties data-particular to the selection of text for use in an other a second document, comprising:

selecting the selection a first portion of text in the a first document;
identifying an XML markup specifying one or more formatting properties associated with the selection of text;

applying the XML markup data to the selection of text; and
associating the applying XML markup with to the selection of text for designating that the selection of text is formatted according to the XML markup data-independent of an other XML markup associated with the other apart from any data applied to other portions of text in the first document or any document into which the selection of text is inserted; and

avoiding a conflict between the XML markup associated with the selection of text and the other XML markup associated with the other document by causing the XML markup associated with the selection of text to be carried with the selection of text when the selection of text is inserted into the other document to maintain the application of the XML markup to the selection of text in the other document independent of the other XML markup associated with the other document.

Respectfully, Takizawa fails to anticipate Claim 1 for at least four reasons.

First, Takizawa neither teaches nor suggests “applying the XML markup to the selection of text.” Takizawa is a “document authoring system” that “converts the XML format data into HTML format data.” (Takizawa; Abstract). As explained by Takizawa, content is converted from XML into HTML such that “a browser is used to easily prepare a desired related disclosure document and the document can be accessed as a web page.” (Takizawa; Paragraph 0018). Accordingly, Takizawa does not “apply XML markup to the selection of text”- instead, Takizawa teaches converting XML markup data to HTML for purposes of displaying XML-formatted data as a web page. Thus, Takizawa fails to teach or suggest “applying the XML markup to the selection of text,” and, thus, for this reason alone, the rejection under 35 U.S.C. § 102(e) should be withdrawn against Claim 1.

Second, Takizawa neither teaches nor suggests “associating the XML markup with the selection of text for designating that the selection of text is formatted according to the XML markup independent of an other XML markup associated with the other document into which the selection of text is inserted.” Again, because Takizawa is directed to translating XML markup data into HTML for presenting an XML-formatted document as a browser web page, Takizawa fails to contemplate “designating that the selection of text is formatted . . . independent of an other XML markup associated with the other document into which the selection of text is inserted.” In translating XML-formatted data into HTML, Takizawa does not contemplate inserting the selection of text into an other document associated with an other XML markup.

Takizawa fails to teach or suggest this limitation, thus providing an additional reason why the rejection under 35 U.S.C. § 102(e) must be withdrawn against Claim 1.

Third, Takizawa neither teaches nor suggests “avoiding a conflict between the XML markup associated with the selection of text and the other XML markup associated with the other document.” Again, Takizawa does not contemplate moving or translating content from one XML document to another XML document and, as a result, there could be no conflict between an XML markup and an other XML markup. Claim 1 thus recites avoiding a conflict that could not possibly arise under Takizawa. Because Takizawa does not – and would not – possibly contemplate resolving an XML markup conflict, Takizawa fails to teach or suggest this limitation and, thus, the rejection under 35 U.S.C. § 102(e) must be withdrawn against Claim 1.

Fourth, Takizawa neither teaches nor suggests “causing the XML markup associated with the selection of text to be carried with the selection of text when the selection of text is inserted into the other document to maintain the application of the XML markup to the selection of text in the other document independent of the other XML markup associated with the other document.” Again, because Takizawa describes an XML to HTML conversion system, Takizawa does not contemplate carrying over the XML markup associated with the selection of text, because Takizawa is directed to converting the XML formatting into HTML. Similarly, by converting content into HTML, Takizawa does not contemplate maintaining the application of the XML markup independent of an other XML markup associated with the other document in which the selection of text is inserted – because Takizawa does not consider the possibility of inserting text into an XML document, Takizawa does not contemplate maintaining the application of XML

markup independent of another XML markup associated with the other document. Respectfully, Takizawa does not and could not teach or suggest this limitation of Claim 1, thus, the rejection under 35 U.S.C. § 102(e) must be withdrawn against Claim 1.

For at least these reasons, applicants respectfully submit that Claim 1 is not anticipated by Claim 1, and the rejection must be withdrawn against Claim 1. Similarly, because Claims 2-9 depend from and apply additional limitations to Claim 1, Claims 1-9 are patentable over Takizawa. Applicants thus submit that the rejection under 35 U.S.C. § 102(e) must be withdrawn against Claims 1-9, and that these claims are in condition for allowance.

Claim 11 also is not anticipated by Takizawa. Again, Takizawa fails to teach or suggest each and every element recited by Claim 11. Accordingly, the rejection under 35 U.S.C. § 102(e) must be withdrawn. Claim 11 as amended is reproduced on the next page for the convenience of the Examiner:

11. (Currently Amended) A method of formatting ~~representing~~ a selection of text from a ~~first~~ document as an Extensible Markup Language (XML) formatted selection such that the selection of text carries formatting data particular to the selection of text for use in an other XML ~~a second~~ document:

- selecting a first portion of text in the a first document;
- applying formatting data particular to the selection of text;
- applying an XML tag to the selection of text whereby the XML tag may be recognized by an XML parsing application as designating that the selection of text is formatted according to the particular formatting data apart from any formatting applied to other portions of text;
- inserting the selection of text into the other XML ~~a second~~ document;
- parsing the other XML ~~second~~ document for other formatting data required for the other XML ~~second~~ document;
- determining the formatting data particular to the selection of text upon encountering the XML tag applied to the selection of text;
- applying the formatting data particular to the selection of text to the selection of text in the other XML ~~second~~ document; and
- formatting ~~displaying~~ the other XML ~~second~~ document whereby the formatting data particular to the selection of text is applied to the selection of text in the other XML ~~second~~ document apart from any formatting applied to any other text contained in the other XML ~~second~~ document.

Takizawa fails to anticipate Claim 11.

Applicants reincorporate the foregoing remarks as to why Takizawa's XML-to-HTML conversion system does not contemplate what is recited by the claims, let alone teach or receive each and every limitation of the claims. Specifically, however, applicants note that Takizawa cannot anticipate Claim 11 for at least two reasons.

First, Takizawa does not contemplate "an other XML document," accordingly, Takizawa fails to teach or suggest "inserting the selection of text into the other XML document." To that end, Takizawa fails to teach or suggest any of the recitations of Claim 11 with regard to "an other XML document," whether "parsing the other XML document," "formatting the other XML

document,” or any other limitation reciting “an other XML document.” Accordingly, because Takizawa does not teach “an other XML document,” Takizawa does not anticipate Claim 11.

Second, because Takizawa does not contemplate the selection of text being included in an other XML document, Takizawa would have no concern about “formatting the other XML document whereby the formatting data particular to the selection of text is applied to the selection of text in the other XML document apart from any formatting applied to any other text contained in the other XML document.” Because Takizawa does not consider multiple XML documents that might include their own XML markups, Takizawa does not teach or suggest that “the formatting data particular to the selection of text is applied . . . apart from any formatting applied to any other text contained in the other XML document.” Again, Takizawa does not contemplate this circumstance, let alone teach this limitation, and thus Takizawa does not anticipate Claim 11.

Similarly, because Claims 12 and 13 depend from and apply additional limitations to Claim 11, Claims 12-13 are patentable over Takizawa. Applicants thus submit that the rejection under 35 U.S.C. § 102(e) must be withdrawn against Claims 11-13, and that these claims are in condition for allowance.

Claim 14 also is not anticipated by Takizawa. Again, Takizawa fails to teach or suggest each and every element recited by Claim 14. Accordingly, the rejection under 35 U.S.C. § 102(e) must be withdrawn. Claim 14 as amended is reproduced below for the convenience of the Examiner:

14. (Currently Amended) A computer storage medium on which is stored instructions which when executed by a computer perform a method of representing a selection of text from a first-document as an Extensible Markup Language (XML) formatted selection such that the selection of text carries formatting data particular to the selection of text for use in a subsequent XML second-document:

selecting a first-portion of text in the a first-document;
identifying an XML markup specifying the formatting data particular to the selection of text;

applying the XML markup formatting data to the selection of text; and
associating the applying XML markup with to the selection of text for designating that the selection of text is formatted according to the XML markup independent of an other XML markup associated with the formatting data apart from any formatting applied to other portions of text in the first document or any subsequent XML document into which the selection of text is inserted; and
avoiding a conflict between the XML markup and the other XML markup by maintaining the association of the XML markup with the selection of text independent of the other XML markup associated with the other document.

Takizawa fails to anticipate Claim 14.

Applicants again reincorporate the foregoing remarks as to why Takizawa's XML-to-HTML conversion system does not contemplate what is recited by the claims, let alone teach or receive each and every limitation of the claims. Specifically, however, applicants note that Takizawa cannot anticipate Claim 14 for at least two reasons.

First, Takizawa does not contemplate "a subsequent XML document" "into which the selection of text is inserted." To that end, Takizawa fails to teach or suggest all of the limitations of Claim 14, and Takizawa cannot anticipate Claim 14.

Second, because Takizawa does not contemplate multiple XML documents, Takizawa does not contemplate, let alone teach or suggest "avoiding a conflict between the XML markup and the other XML markup by maintaining the association of the XML markup with the

selection of text independent of the other XML markup associated with the other document.” If there is only one XML document, there is no conflict between XML markups, and Takizawa fails to teach or suggest otherwise. Accordingly, Takizawa does not anticipate Claim 14.

Similarly, because Claims 15-20 depend from and apply additional limitations to Claim 14, Claims 15-20 are patentable over Takizawa. Applicants thus submit that the rejection under 35 U.S.C. § 102(e) must be withdrawn against Claims 14-20, and that these claims are in condition for allowance.

Claim Rejections under 35 U.S.C. § 103

The Office Action rejected Claims 5-9, 12, and 16-19 as being unpatentable under 35 U.S.C. § 103(a) over Takizawa. As previously described, Claims 5-9, 12, and 16-19 depend from and apply additional limitations to the respective independent claims from which each depends. Thus, because independent Claims 1, 11, and 14 are patentable for the reasons previously described, applicants submit that Claims 5-9, 12, and 16-19 are patentable over Takizawa.

Applicants assert two additional reasons why one of ordinary skill in the art at the time the invention was made, even if that person had knowledge of Takizawa, would have found what is recited in Claims 5-9, 12, and 16-19 – or any of the other claims – to be obvious. First, because Takizawa does not teach all of the limitations of the claims, Takizawa cannot support a *prima facie* case of obviousness against the claims. Section 706.02(j) of the Manual of Patent

Examining Procedure expressly requires “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” As previously described, Takizawa fails to teach or suggest the use of a second XML document. Accordingly, Takizawa fails to support an obviousness rejection of the claims.

Second, respectfully, the Office Action’s suggestion that Takizawa renders obvious the use of a second XML document is incorrect. Specifically, the Office Action suggests that XML and HTML are both markup languages that use tags, thus it would have been obvious to maintain the formatting of XML text upon inserting it into a second XML document. *See* Office Action, Pages 8-9. Respectfully, in making this assertion, the Office Action ignores two significant points. First, because XML and HTML are different formatting languages, there is no suggestion that the markups under each language would conflict with each other so that the markup under one would have to be preserved in the face of the other. Second, the Office Action also ignores that Takizawa teaches a system for translating from XML into HTML. Respectfully, the languages cannot be substituted for each other if one must be translated to another. If anything, by focusing on translating from one markup language to the other, Takizawa teaches away from the possibility of simply replacing a second XML document for the HTML document described by Takizawa. Again, applicants respectfully assert that Takizawa, therefore, cannot support an obviousness rejection of Claims 5-9, 12, and 16-19, or any of the claims at issue.

CONCLUSION

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicants at the telephone number provided below.

Respectfully submitted,

MERCHANT & GOULD P.C.



Frank J. Bozzo
Registration No. 36,756
Direct Dial: 206.342.6294

MERCHANT & GOULD P.C.
P. O. Box 2903
Minneapolis, Minnesota 55402-0903
206.342.6200

